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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/724,983	11/28/2000	Scott A. Waldman	TJU-2444	8378

7590

03/27/2002

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EXAMINER

RAWLINGS, STEPHEN L

ART UNIT

PAPER NUMBER

1642

DATE MAILED: 03/27/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/724,983

Applicant(s)

Examiner

Steve Rawlings

Art Unit

1642

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-49 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 2-49 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 2-10, 12-19, 37-40, 43-44, 47-49, drawn to peptide compound which binds to a ST receptor, classified in class 530, subclass 300. If Group I is elected the claims will be examined to the extent the compound is a peptide.
 - II. Claims 11 and 21, 23 in part and claims 24-26, 29-30, 33, 34, 35, 36 drawn to a method of treating an individual with a peptide, classified in class 514, subclass 2.
 - III. Claim 20, drawn to a method of radio imaging, classified in class 424, subclass 1.11.
 - IV. Claim 22, drawn to a method of delivery of a nucleic acid to an individual, classified in class 514, subclass 44.
 - V. Claims, 23 in part and claims 27, 28, 30, 31, 32, 36 drawn to a method of treating an individual with an antibody, classified in class 424, subclass 178.1.
 - VI. Claims 37, 41, 42, 43, 44, 45, 46, drawn to an antibody and compositions comprising such, classified in class 530, subclass 387.1.
2. The inventions are distinct, each from the other because of the following reasons:

Inventions of Groups I and VI represent separate and distinct products which are made by materially different methods, and are used in materially different methods which have different modes of operation, different functions and different effects. The peptide of Group I and the antibody of Group VI are all structurally and chemically different from each other. The peptide is made by translation of mRNA and the antibody is raised by immunization. Furthermore, the polypeptide can be used for methods of treatment and the antibody can be used to immunopurify the polypeptide, for example. The examination of all groups would require different searches in the U.S. Patent shoes and the scientific literature and would require the consideration of different patentability issues. Thus the inventions I and VI are patentably distinct.

The methods of Inventions II-V differ in the method objectives, method steps and parameters and in the reagents used. Invention II to a method of treating an individual with a peptide; Invention III a method of radio imaging; Invention IV a method of delivery of a nucleic acid to an individual; Invention V a method of treating an individual with an antibody. The examination of all groups would require different searches in the U.S. PATENT shoes and the scientific literature and would require the consideration of different patentability issues. Thus Inventions II-V are separate and distinct in having different method objectives, method steps and parameters and in the reagents used and are patentably distinct.

Inventions I and II-III are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially

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different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the peptide of Group I can be used in either materially different methods of Groups II-III.

Inventions VI and V are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the antibody of Group VI can be used in a materially different method such as to immunopurify the antigen in addition to the materially different method of Group V.

3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter and different classifications, restriction for examination purposes as indicated is proper.

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steve Rawlings., whose telephone number is (703) 305-3008. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anthony Caputa, can be reached on (703) 308-3995. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

5. Papers related to this application may be submitted to Group 1600 by facsimile transmission. Papers should be faxed to Group 1600 via the PTO Fax Center located in


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Crystal Mall 1. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). The CM1 Fax Center telephone number is (703) 308-4242.

Respectfully,
Larry R. Helms Ph.D.
703-306-5879


ANTHONY C. CAPUTO
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600